

Appln. No. 10/622,945  
Amendment dated April 15, 2005  
Reply to Office Action mailed January 25, 2005

**REMARKS**

Reconsideration is respectfully requested.

Claims 1, 2 and 5 through 9 remain in this application. Claims 3 and 4 have been cancelled.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

**Paragraph 3 of the Office Action**

Claims 1, 2 and 5 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over US 2003/0010371 A1 to Langley in view of U.S. Patent 4,716,918 to Hayashida et al.

In regard to claim 1, it is submitted that the combination of Langley with Hayashida is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "each of said side walls having a plurality of ventilation holes extending through said respective side wall, said ventilation holes being positioned proximate said top wall of said housing such that said ventilation holes are adapted for exhausting warm exhaled air from the user for preventing the exhaled breath from fogging said window panel, said side walls being positioned on opposing sides of said front wall such that said ventilation holes of said side walls are positioned on opposing sides of the user to inhibit air flow through said ventilation holes from being directed into a face of the user". The Langley reference teaches a portable rain seat enclosure that fails to teach the side walls having ventilation holes positioned proximate to the top of each of the side walls with the side walls being positioned on either side of the front wall to inhibit air flow through the ventilation holes from being directed into the face of the user as claimed the applicants. Further, the Langley reference is completely silent on the use of holes to provide any ventilation for the

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occupant of the enclosure which is further supported by the Office Action's statement:

"Langley fails to provide that each of the side walls has a plurality of ventilation holes positioned proximate the top of a shelter."

Therefore, the Langley reference fails to provide any motivation for such a modification. The Hayashida reference teaches a tent that fails to teach the side walls having ventilation holes positioned proximate to the top of each of the side walls with the side walls being positioned on either side of the front wall to inhibit air flow through the ventilation holes from being directed into the face of the user as claimed the applicants. Further, the Hayashida reference teaches away from that claimed by the applicants in that the Hayashida reference teaches the air outlet openings being positioned on the panel that forms the head end of the tent and therefore does not teach the ventilation holes being positioned on the side walls on opposite sides of the front wall as claimed by the applicants. Additionally, the Hayashida reference provides no motivation for combination with the Langley reference in that the Hayashida reference is meant to cover an occupant when the occupant is lying in a prone position and provides no means for the occupant to view out of the tent and therefore would not lead one to combine features of the Hayashida with those of the Langley reference. It is further submitted that when a suggestion or motivation to combine selected elements of prior art references is not supplied by the prior art, the incentive to make such a combination can only come from improper hindsight reconstruction using the applicants' specification.

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed

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elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonic, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ 2d 1551, 1554 (Fed. Cir. 1996).

*In re Rouffet*, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998)

Therefore, it is submitted that that the combination of the Langley reference with the Hayashida reference would not lead one to the combination of features as claimed by the applicants.

Claims 2 and 5 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 2 and 5 are also believed to be allowable over the cited reference.

Withdrawal of the §103(a) rejection of claims 1, 2 and 5 is therefore respectfully requested.

#### **Paragraph 4 of the Office Action**

Claims 1, 2 and 5 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over US 2003/0010371 A1 to Langley in view of U.S. Patent 6,334,278 to Arnold.

In regard to claim 1, it is submitted that the combination of Langley with Arnold is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "each of said side walls having a plurality of ventilation holes extending through said respective side wall, said ventilation holes being positioned proximate said top wall of said housing such that said ventilation holes are adapted for exhausting warm exhaled air from the user for preventing the exhaled breath from fogging said window panel, said side walls being positioned on opposing sides of said front wall such that said ventilation holes of said side walls are positioned on opposing sides of the user to inhibit air flow through said ventilation holes

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from being directed into a face of the user". As discussed above, the Langley reference fails to teach the side walls having ventilation holes positioned proximate to the top of each of the side walls with the side walls being positioned on either side of the front wall to inhibit air flow through the ventilation holes from being directed into the face of the user as claimed the applicants. Additionally, as discussed above, the Langley reference's is completely silent on the use of holes to provide any ventilation for the occupant of the enclosure and therefore fails to provide any motivation for such a modification. The Arnold reference provides no motivation for combination with the Langley reference in that the Arnold reference is meant to be a semi-permanent structure to protect the occupant from harmful weather such as tornados so to have the structure as portable as the Langley reference would provide no protection from a tornado and additionally the Arnold reference provides no means for the occupant to view out of the room and thus would not lead one to combine features of the Arnold with those of the Langley reference. It is further submitted that when a suggestion or motivation to combine selected elements of prior art references is not supplied by the prior art, the incentive to make such a combination can only come from improper hindsight reconstruction using the applicants' specification.

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ 2d 1551, 1554 (Fed. Cir. 1996).

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*In re Rouffet*, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998)

Therefore, it is submitted that that the combination of the Langley reference with the Arnold reference would not lead one to the combination of features as claimed by the applicants.

Claims 2 and 5 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 2 and 5 are also believed to be allowable over the cited reference.

Withdrawal of the §103(a) rejection of claims 1, 2 and 5 is therefore respectfully requested.

**Paragraph 5 of the Office Action**

Claims 1, 2 and 5 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over US Patent 3,052,251 to De Jean Jr. in view of U.S. Patent 4,716,918 to Hayashida et al.

In regard to claim 1, it is submitted that the combination of De Jean, Jr. with Hayashida is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "each of said side walls having a plurality of ventilation holes extending through said respective side wall, said ventilation holes being positioned proximate said top wall of said housing such that said ventilation holes are adapted for exhausting warm exhaled air from the user for preventing the exhaled breath from fogging said window panel, said side walls being positioned on opposing sides of said front wall such that said ventilation holes of said side walls are positioned on opposing sides of the user to inhibit air flow through said ventilation holes from being directed into a face of the user". The De Jean, Jr. reference teaches a spectator shelter that fails to teach the side walls having ventilation holes positioned proximate to the top of each of the side walls with the side walls being positioned on either side of the front wall to

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inhibit air flow through the ventilation holes from being directed into the face of the user as claimed the applicants. Further, the De Jean, Jr. reference is completely silent on the use of holes to provide any ventilation for the occupant of the shelter which is further supported by the Office Action's statement:

"De Jean fails to provide ventilation holes on each of the side wall adjacent the top thereof."

Therefore, the De Jean, Jr. reference fails to provide any motivation for such a modification. The Hayashida reference teaches a tent that fails to teach the side walls having ventilation holes positioned proximate to the top of each of the side walls with the side walls being positioned on either side of the front wall to inhibit air flow through the ventilation holes from being directed into the face of the user as claimed the applicants. Further, the Hayashida reference teaches away from that claimed by the applicants in that the Hayashida reference teaches the air outlet openings being positioned on the panel that forms the head end of the tent and therefore does not teach the ventilation holes being positioned on the side walls on opposite sides of the front wall as claimed by the applicants. Additionally, the Hayashida reference provides no motivation for combination with the De Jean, Jr. reference in that the Hayashida reference is meant to cover an occupant when the occupant is lying in a prone position and provides no means for the occupant to view out of the tent and therefore would not lead one to combine features of the Hayashida with those of the De Jean, Jr. reference. It is further submitted that when a suggestion or motivation to combine selected elements of prior art references is not supplied by the prior art, the incentive to make such a combination can only come from improper hindsight reconstruction using the applicants' specification.

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly

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of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ 2d 1551, 1554 (Fed. Cir. 1996).

*In re Rouffet*, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998)

Therefore, it is submitted that that the combination of the De Jean, Jr. reference with the Hayashida reference would not lead one to the combination of features as claimed by the applicants.

Claims 2 and 5 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 2 and 5 are also believed to be allowable over the cited reference.

Withdrawal of the §103(a) rejection of claims 1, 2 and 5 is therefore respectfully requested.

#### **Paragraph 6 of the Office Action**

Claims 1, 2 and 5 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over US Patent 3,052,251 to De Jean Jr. in view of U.S. Patent 6,334,278 to Arnold.

In regard to claim 1, it is submitted that the combination of De Jean, Jr. with Arnold is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "each of said side walls having a plurality of ventilation holes extending through said respective side wall, said ventilation holes being positioned proximate said top wall of said housing such that said ventilation holes are adapted for exhausting warm exhaled air from the user for preventing the exhaled breath from fogging said window

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panel, said side walls being positioned on opposing sides of said front wall such that said ventilation holes of said side walls are positioned on opposing sides of the user to inhibit air flow through said ventilation holes from being directed into a face of the user". As discussed above, the De Jean, Jr. reference fails to teach the side walls having ventilation holes positioned proximate to the top of each of the side walls with the side walls being positioned on either side of the front wall to inhibit air flow through the ventilation holes from being directed into the face of the user as claimed the applicants. Additionally, as discussed above, the De Jean, Jr. reference is completely silent on the use of holes to provide any ventilation for the occupant of the shelter and therefore fails to provide any motivation for such a modification. The Arnold reference provides no motivation for combination with the De Jean, Jr. reference in that the Arnold reference is meant to be a semi-permanent structure to protect the occupant from harmful weather such as tornados so to have the structure as portable as the De Jean, Jr. reference would provide no protection from a tornado and additionally the Arnold reference provides no means for the occupant to view out of the room and thus would not lead one to combine features of the Arnold with those of the De Jean, Jr. reference. It is further submitted that when a suggestion or motivation to combine selected elements of prior art references is not supplied by the prior art, the incentive to make such a combination can only come from improper hindsight reconstruction using the applicants' specification.

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself



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as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonic, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ 2d 1551, 1554 (Fed. Cir. 1996).

*In re Rouffet*, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998)

Therefore, it is submitted that that the combination of the De Jean, Jr. reference with the Arnold reference would not lead one to the combination of features as claimed by the applicants.

Claims 2 and 5 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 2 and 5 are also believed to be allowable over the cited reference.

Withdrawal of the §103(a) rejection of claims 1, 2 and 5 is therefore respectfully requested.

#### Paragraph 7 of the Office Action

Claims 6 and 7 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over US Patent 3,052,251 to De Jean Jr. as modified by U.S. Patent 4,716,918 to Hayashida et al above further in view of U.S. Patent Re. 29,264 to Woodward.

In regard to claim 1, it is submitted that the combination of De Jean, Jr. with Hayashida and Woodward is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "each of said side walls having a plurality of ventilation holes extending through said respective side wall, said ventilation holes being positioned proximate said top wall of said housing such that said ventilation holes are adapted for exhausting warm exhaled air from the user for preventing the exhaled breath from fogging said window panel, said side walls being positioned on opposing sides of said front wall such that said ventilation holes of said side walls are positioned on opposing sides of the user to inhibit air flow through said

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ventilation holes from being directed into a face of the user". As discussed above, the De Jean, Jr. reference fails to teach the side walls having ventilation holes positioned proximate to the top of each of the side walls with the side walls being positioned on either side of the front wall to inhibit air flow through the ventilation holes from being directed into the face of the user as claimed the applicants. Additionally, as discussed above, the De Jean, Jr. reference is completely silent on the use of holes to provide any ventilation for the occupant of the shelter and therefore fails to provide any motivation for such a modification. As discussed above, the Hayashida reference teaches away from the side walls having ventilation holes positioned proximate to the top of each of the side walls with the side walls being positioned on either side of the front wall to inhibit air flow through the ventilation holes from being directed into the face of the user as claimed the applicants. Additionally, as discussed above, the Hayashida reference provides no motivation for combination with the De Jean, Jr. reference. The Woodward reference teaches a tent for rear-doored vehicle that fails to teach the side walls having ventilation holes positioned proximate to the top of each of the side walls with the side walls being positioned on either side of the front wall to inhibit air flow through the ventilation holes from being directed into the face of the user as claimed the applicants. It is further submitted that when a suggestion or motivation to combine selected elements of prior art references is not supplied by the prior art, the incentive to make such a combination can only come from improper hindsight reconstruction using the applicants' specification.

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed

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elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonic, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ 2d 1551, 1554 (Fed. Cir. 1996).

*In re Rouffet*, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998)

Therefore, it is submitted that that the combination of the De Jean, Jr. reference with the Hayashida and Woodward references would not lead one to the combination of features as claimed by the applicants.

Claims 6 and 7 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 6 and 7 are also believed to be allowable over the cited reference.

Withdrawal of the §103(a) rejection of claims 6 and 7 is therefore respectfully requested.

#### **Paragraph 8 of the Office Action**

Claims 6 and 7 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over US Patent 3,052,251 to De Jean Jr. as modified by U.S. Patent 6,334,278 to Arnold above further in view of U.S. Patent Re. 29,264 to Woodward.

In regard to claim 1, it is submitted that the combination of De Jean, Jr. with Arnold and Woodward is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "each of said side walls having a plurality of ventilation holes extending through said respective side wall, said ventilation holes being positioned proximate said top wall of said housing such that said ventilation holes are adapted for exhausting warm exhaled air from the user for preventing the exhaled breath from fogging said window panel, said side walls being positioned on opposing sides of said front wall such that said ventilation holes of said side walls are

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positioned on opposing sides of the user to inhibit air flow through said ventilation holes from being directed into a face of the user". As discussed above, the De Jean, Jr. reference fails to teach the side walls having ventilation holes positioned proximate to the top of each of the side walls with the side walls being positioned on either side of the front wall to inhibit air flow through the ventilation holes from being directed into the face of the user as claimed the applicants. Additionally, as discussed above, the De Jean, Jr. reference is completely silent on the use of holes to provide any ventilation for the occupant of the shelter and therefore fails to provide any motivation for such a modification. As discussed above, the Arnold reference teaches away from the side walls having ventilation holes positioned proximate to the top of each of the side walls with the side walls being positioned on either side of the front wall to inhibit air flow through the ventilation holes from being directed into the face of the user as claimed the applicants. Additionally, as discussed above, the Arnold reference provides no motivation for combination with the De Jean, Jr. reference. As discussed above, the Woodward reference fails to teach the side walls having ventilation holes positioned proximate to the top of each of the side walls with the side walls being positioned on either side of the front wall to inhibit air flow through the ventilation holes from being directed into the face of the user as claimed the applicants. It is further submitted that when a suggestion or motivation to combine selected elements of prior art references is not supplied by the prior art, the incentive to make such a combination can only come from improper hindsight reconstruction using the applicants' specification.

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate

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patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonic, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ 2d 1551, 1554 (Fed. Cir. 1996).

*In re Rouffet*, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998)

Therefore, it is submitted that the combination of the De Jean, Jr. reference with the Arnold and Woodward references would not lead one to the combination of features as claimed by the applicants.

Claims 6 and 7 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 6 and 7 are also believed to be allowable over the cited reference.

Withdrawal of the §103(a) rejection of claims 6 and 7 is therefore respectfully requested.

#### **Paragraph 9 of the Office Action**

Claims 1, 2, 5 and 8 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over US Patent 3,491,781 to Reese in view of US. Patent 4,716,918 to Hayashida et al.

In regard to claim 1, it is submitted that the combination of Reese with Hayashida is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "each of said side walls having a plurality of ventilation holes extending through said respective side wall, said ventilation holes being positioned proximate said top wall of said housing such that said ventilation holes are adapted for exhausting warm exhaled air from the user for preventing the exhaled breath from fogging said window panel, said side walls being positioned on opposing sides of said front wall such that said ventilation holes of said side walls are positioned on

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opposing sides of the user to inhibit air flow through said ventilation holes from being directed into a face of the user". The Reese reference teaches a collapsible seating enclosure that fails to teach the side walls having ventilation holes positioned proximate to the top of each of the side walls with the side walls being positioned on either side of the front wall to inhibit air flow through the ventilation holes from being directed into the face of the user as claimed the applicants. Further, the Reese reference is completely silent on the use of holes to provide any ventilation for the occupant of the enclosure which is further supported by the Office Action's statement:

"Reese fails to provide that each of the side walls has a plurality of ventilation holes positioned proximate the top of the housing."

Therefore, the Reese reference fails to provide any motivation for such a modification. As discussed above, the Hayashida reference fails to teach the side walls having ventilation holes positioned proximate to the top of each of the side walls with the side walls being positioned on either side of the front wall to inhibit air flow through the ventilation holes from being directed into the face of the user as claimed the applicants. Further, the Hayashida reference teaches away from that claimed by the applicants in that the Hayashida reference teaches the air outlet openings being positioned on the panel that forms the head end of the tent and therefore does not teach the ventilation holes being positioned on the side walls on opposite sides of the front wall as claimed by the applicants. Additionally, the Hayashida reference provides no motivation for combination with the Reese reference in that the Hayashida reference is meant to cover an occupant when the occupant is lying in a prone position and provides no means for the occupant to view out of the tent and therefore would not lead one to combine features of the Hayashida with those of the Reese reference. It is further submitted that when a suggestion or motivation to combine selected elements of prior art references is not supplied by the prior art, the

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incentive to make such a combination can only come from improper hindsight reconstruction using the applicants' specification.

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ 2d 1551, 1554 (Fed. Cir. 1996).

*In re Rouffet*, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998)

Therefore, it is submitted that that the combination of the Reese reference with the Hayashida reference would not lead one to the combination of features as claimed by the applicants.

Claims 2, 5 and 8 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 2, 5 and 8 are also believed to be allowable over the cited reference.

Withdrawal of the §103(a) rejection of claims 1, 2, 5 and 8 is therefore respectfully requested.

#### **Paragraph 10 of the Office Action**

Claims 1, 2, 5 and 8 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over US Patent 3,491,781 to Reese in view of US. Patent 6,334,278 to Arnold.

In regard to claim 1, it is submitted that the combination of Reese with Arnold is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of

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features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "each of said side walls having a plurality of ventilation holes extending through said respective side wall, said ventilation holes being positioned proximate said top wall of said housing such that said ventilation holes are adapted for exhausting warm exhaled air from the user for preventing the exhaled breath from fogging said window panel, said side walls being positioned on opposing sides of said front wall such that said ventilation holes of said side walls are positioned on opposing sides of the user to inhibit air flow through said ventilation holes from being directed into a face of the user". As discussed above, the Reese reference fails to teach the side walls having ventilation holes positioned proximate to the top of each of the side walls with the side walls being positioned on either side of the front wall to inhibit air flow through the ventilation holes from being directed into the face of the user as claimed the applicants. Additionally, as discussed above, the Reese reference is completely silent on the use of holes to provide any ventilation for the occupant of the shelter and therefore fails to provide any motivation for such a modification. The Arnold reference provides no motivation for combination with the Reese reference in that the Arnold reference is meant to be a semi-permanent structure to protect the occupant from harmful weather such as tornados so to have the structure as portable as the Reese reference would provide no protection from a tornado and additionally the Arnold reference provides no means for the occupant to view out of the room and thus would not lead one to combine features of the Arnold with those of the Reese reference. It is further submitted that when a suggestion or motivation to combine selected elements of prior art references is not supplied by the prior art, the incentive to make such a combination can only come from improper hindsight reconstruction using the applicants' specification.

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713



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F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ 2d 1551, 1554 (Fed. Cir. 1996).

*In re Rouffet*, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998)

Therefore, it is submitted that that the combination of the Reese reference with the Arnold reference would not lead one to the combination of features as claimed by the applicants.

Claims 2, 5 and 8 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 2, 5 and 8 are also believed to be allowable over the cited reference.

Withdrawal of the §103(a) rejection of claims 1, 2, 5 and 8 is therefore respectfully requested.

#### **Paragraph 11 of the Office Action**

Claim 9 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over US Patent 3,491,781 to Reese in view of US. Patent 4,716,918 to Hayashida et al as modified above further in view of U.S. Patent Re. 29,264 to Woodward.

In regard to claim 9, it is submitted that the combination of Reese with Hayashida and Woodward is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "each of said side walls having a plurality of ventilation holes extending through said respective side wall,

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said ventilation holes being positioned proximate said top wall of said housing such that said ventilation holes are adapted for exhausting warm exhaled air from the user for preventing the exhaled breath from fogging said window panel, said side walls being positioned on opposing sides of said front wall such that said ventilation holes of said side walls are positioned on opposing sides of the user to inhibit air flow through said ventilation holes from being directed into a face of the user". The Reese reference teaches a collapsible seating enclosure that fails to teach the side walls having ventilation holes positioned proximate to the top of each of the side walls with the side walls being positioned on either side of the front wall to inhibit air flow through the ventilation holes from being directed into the face of the user as claimed the applicants. Further, the Reese reference is completely silent on the use of holes to provide any ventilation for the occupant of the enclosure which is further supported by the Office Action's statement:

"Reese fails to provide that each of the side walls has a plurality of ventilation holes positioned proximate the top of the housing."

Therefore, the Reese reference fails to provide any motivation for such a modification. As discussed above, the Hayashida reference teaches away from the side walls having ventilation holes positioned proximate to the top of each of the side walls with the side walls being positioned on either side of the front wall to inhibit air flow through the ventilation holes from being directed into the face of the user as claimed the applicants. Additionally, as discussed above, the Hayashida reference provides no motivation for combination with the Reese reference. The Woodward reference teaches a tent for rear-doored vehicle that fails to teach the side walls having ventilation holes positioned proximate to the top of each of the side walls with the side walls being positioned on either side of the front wall to inhibit air flow through the ventilation holes from being directed into the face of the user as claimed the applicants. It is further submitted that when a suggestion or motivation to combine selected elements of prior art

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references is not supplied by the prior art, the incentive to make such a combination can only come from improper hindsight reconstruction using the applicants' specification.

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonic, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ 2d 1551, 1554 (Fed. Cir. 1996).

*In re Rouffet*, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998)

Therefore, it is submitted that that the combination of the Reese reference with the Hayashida and Woodward references would not lead one to the combination of features as claimed by the applicants.

Withdrawal of the §103(a) rejection of claim 9 is therefore respectfully requested.

#### **Paragraph 12 of the Office Action**

Claim 9 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over US Patent 3,491,781 to Reese in view of US. Patent 6,334,278 to Arnold as modified above further in view of U.S. Patent Re. 29,264 to Woodward.

In regard to claim 9, it is submitted that the combination of Reese with Arnold and Woodward is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the

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references do not disclose, teach or suggest "each of said side walls having a plurality of ventilation holes extending through said respective side wall, said ventilation holes being positioned proximate said top wall of said housing such that said ventilation holes are adapted for exhausting warm exhaled air from the user for preventing the exhaled breath from fogging said window panel, said side walls being positioned on opposing sides of said front wall such that said ventilation holes of said side walls are positioned on opposing sides of the user to inhibit air flow through said ventilation holes from being directed into a face of the user". As discussed above, the Reese reference fails to teach the side walls having ventilation holes positioned proximate to the top of each of the side walls with the side walls being positioned on either side of the front wall to inhibit air flow through the ventilation holes from being directed into the face of the user as claimed the applicants. Additionally, as discussed above, the Reese reference is completely silent on the use of holes to provide any ventilation for the occupant of the shelter and therefore fails to provide any motivation for such a modification. As discussed above, the Arnold reference teaches away from the side walls having ventilation holes positioned proximate to the top of each of the side walls with the side walls being positioned on either side of the front wall to inhibit air flow through the ventilation holes from being directed into the face of the user as claimed the applicants. Additionally, as discussed above, the Arnold reference provides no motivation for combination with the Reese reference. As discussed above, the Woodward reference fails to teach the side walls having ventilation holes positioned proximate to the top of each of the side walls with the side walls being positioned on either side of the front wall to inhibit air flow through the ventilation holes from being directed into the face of the user as claimed the applicants. It is further submitted that when a suggestion or motivation to combine selected elements of prior art references is not supplied by the prior art, the incentive to make such a combination can only

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come from improper hindsight reconstruction using the applicants' specification.

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ 2d 1551, 1554 (Fed. Cir. 1996).

*In re Rouffet*, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998)

Therefore, it is submitted that that the combination of the Reese reference with the Arnold and Woodward references would not lead one to the combination of features as claimed by the applicants.

Withdrawal of the §103(a) rejection of claim 9 is therefore respectfully requested.

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**CONCLUSION**

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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By 

Date: \_\_\_\_\_

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